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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,363	01/26/2001	Yoshihiro Ishida	35.G2725	4785
5514	7590	08/17/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,363

Applicant(s)

ISHIDA ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-13, and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 7/12/06.
- Claims 1-2, 5-13, and 16-23 are pending; claims 3-4, and 14-15 have been canceled.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid. Applicant's submission filed on 7/12/06 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5-13, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (U.S. 5621810), and in view of Yamakawa et al (US 5809366).

Regarding claim 1, Suzuki discloses an image processing apparatus (copy machine, fig. 2) comprising:

- image-data input means (image scanner 201, fig. 2, col. 4, lines 1-20) for inputting image data;
- specific-image determination means (prohibition pattern detection means, fig. 36, col. 2, lines 1-50 and col. 4, lines 36-64) for determining whether the image data inputted by said image-data input means represents a specific image having predetermined characteristics (i.e. digital watermark, figs. 14-15).

However, Suzuki does not expressly disclose (1) re-input determination means for determining whether to output a signal urging re-input of the image data input by said image-data input means, said re-input determination means including difficulty determination means for

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determining whether the determination by said specific-image determination means is difficult, wherein said re-input determination means determines whether to output the signal urging re-input of the image data based on the determination by said difficulty determination means; and (2) signal output means for outputting the signal urging re-input of the image data, in accordance with a result of the determination by said re-input determination means.

Yamakawa, in the same field of endeavor for printing, teaches (1) re-input determination means (image processor 3 of copy machine 1, fig. 4) for determining whether to output a signal urging re-input (warning message for urging user to execute scanning again, col. 14, lines 30-35) of the image data input by said image-data input means, said re-input determination means including difficulty determination means (image processor 3 further includes CPU 517, fig. 18) for determining whether the determination by said specific-image determination means is difficult (col. 14, lines 30-35), wherein said re-input determination means determines whether to output the signal urging re-input (message urging re-scanning of image data, col. 14, lines 30-35) of the image data based on the determination by said difficulty determination means; and (2) signal output means for outputting the signal urging re-input of the image data (message urging re-scanning of image data, col. 14, lines 30-35) by said re-input determination means.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify image processing apparatus of Suzuki to include a re-input means for re-input original image to read again because of difficulty of reading the first scan as per teachings of Yamakawa because of a following reason: (●) to accurately detects security marks/originals by ensuring the inputted image is scanned correctly and accurately; (●) to obtain high quality of outputted documents if the documents are not copy-prohibited by ensuring the documents are properly read/scan.

Therefore, it would have been obvious to combine Suzuki with Yamakawa to obtain the invention as specified in claim 1.

Regarding claim 2, Suzuki further discloses an image processing apparatus according to claim 1, wherein said specific-image determination means determines whether the image data obtained from said image-data input means represents a copy-prohibition image (i.e. money, fig. 14a).

Regarding claim 5, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means comprises difficulty calculation means (pattern matching determination means by determining position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) for calculating difficulty in determination whether the image data represents the specific image, and difficulty determination means for determining whether the determination of said specific-image determination means is difficult based on the difficulty calculated by said difficulty calculation means.

Regarding claim 6, Suzuki further discloses an image processing apparatus according to claim 2, wherein said re-input determination means comprises difficulty calculation means for calculating difficulty in determination whether the image data represents a copy-prohibition image, and difficulty determination means (col. 2, lines 1-50 and cols. 9-10) for determining whether the determination whether the image data represents a copy-prohibition image is difficult, based on the difficulty calculated by said difficulty calculation means.

Regarding claim 7, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means determines whether the re-input is to be urged, from data based on a position of an original (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) in an image represented by the input image data.

Regarding claim 8, Suzuki further discloses an image processing apparatus according to claim 5, wherein said difficulty calculation means calculates the difficulty in the determination of the specific image, from data based on a position (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination by said specific-image determination means is difficult, by comparing data of the difficulty calculated by said difficulty calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claim 9, Suzuki further discloses an image processing apparatus according to claim 6, wherein said difficulty calculation means calculates the difficulty in the determination of a copy-prohibition image, from data based on a position (position calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination of a copy-prohibition image is difficult, by comparing data of the difficulty calculated by said difficulty calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claim 10, Suzuki an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is an angle (angle calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of the original with respect to a scanning direction (fig. 1) of the image represented by the input image data.

Regarding claim 11, Suzuki further discloses an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is a deviation (i.e. angular and positional difference, cols. 8-10) of the original from a predetermined position with respect to a scanning direction of the image represented by the input image data.

Regarding claims 12-13, 16-22: Claims 12-13, 16-22 are the method claims corresponding to the apparatus claims 1-2, 5-11. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-2, 5-11 above.

Claim 23 corresponds to claim 1 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have some type of computer readable memory medium (RAM, fig. 4) for storing computer programs; therefore, claim 23 would be rejected using the same rationale as in claim 1.

Response to Arguments

Applicant's arguments filed 5/16/06 have been fully considered but they are not persuasive.

The arguments presented by the applicants have been considered, but are not persuasive. The applicants argued the cited prior art of record (US 5809366 to Yamakawa) fails to teach and/or suggest the feature of re-input determination means including difficulty determination means for determining whether a determination by a specific-image determination means is difficult, wherein the re-input determination means determines whether to output a signal urging re-input of image data based on the determination by the difficulty determination means.

In response, the examiner disagrees with applicants' arguments/assertions. According to the originally filed specification by the applicants, it is difficult to determine (difficulty determination means) whether the image data represents a specific image (i.e. copy-prohibition image) depends upon a mounting angle of the originals (fig. 4, page 13, lines 18-25); in other words, it is difficult to calculate and to determine if the originals contain copy-prohibited image based upon a mounting angle of the original on the platen of the scanner. For example, if a mounting angle with respect to the platen is zero, then proceeds to calculate and to determine whether the original contains a confidential mark; and if a mounting angle with respect to the platen is greater than zero, a message indicating to an operator to re-position (and to re-input/re-scan) the original so a mounting angle is aligned at a zero degree with respect to platen surface (see figs. 4-6 for details). Mounting angle of an original document is calculated by reading and/or detecting four corner coordinates (Pa, Pb, Pc, and Pd) as shown in fig. 6. Suzuki teaches an image forming apparatus provided with a detection means (col. 2, lines 3-5) for detecting the positioned state of an original image/document (col. 4, lines 45-52), difficult determination means for calculating angle of original with respect to platen surface via reading and/or detecting four corner coordinates A, B, C, and D as shown in fig. 11 & 14, see col. 8, lines 10-55. Angle and position calculations of original document and confidential mark are calculated based upon these four detected coordinates (col. 8, lines 10-67 and col. 11, lines 28-32). Suzuki also teaches an example of reading/scanning an original document multiple times (i.e. re-scan original document), see col. 11, lines 23-32. However, Suzuki does not explicitly teach outputting a

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signal urging user to re-input (i.e scan again) or re-scan the original image data. For above deficiency, the examiner has relied upon Yamakawa for such teachings. Yamakawa teaches an example of outputting a signal urging re-inputting (i.e. scan again) of the image if the scanned version of the original image is not acceptable for processing (col. 14, lines 30-40).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

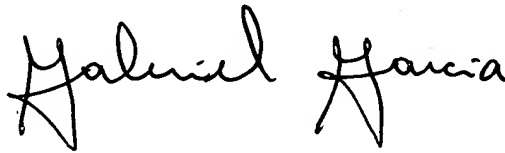
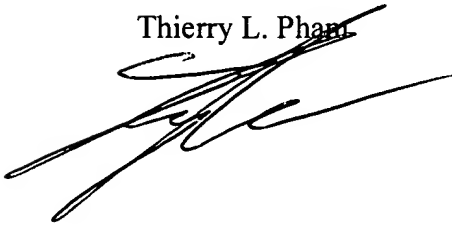
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham



GABRIEL I. GARCIA
PRIMARY EXAMINER